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EXAMINER	
ASHBURN, STEVEN L	

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/809,922	THOMAS, WILLIAM L.	
	Examiner	Art Unit	
	Steven Ashburn	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 July 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32 and 65-84* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-32 and 65-84* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

Claims 1, 11, 65 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson et al, GB 2,147,773 A (May 15, 1985) in view of Sarno, US 6,024,641 (Feb. 15, 2000) and Tso et al., U.S. 6,047,327 (Apr. 4, 2000).

Dickinson discloses an interactive lottery system that displays a list of lotteries, including government lotteries, in which a user participates in at least one of the lotteries on a CRT display. *See. fig. 1, 6-9B; pp. 1:24-29, 10:48-11:50.* Dickinson teaches all the features of the claims except (i) using user equipment and (ii) limiting the list of lotteries based on a user's particular location. Regardless, as discussed below, these features would have been obvious to an artisan at the time of the invention.

Regarding the user equipment, the examiner interprets the term "user equipment" to mean equipment that is the possession of player (e.g. owned or leased) rather than owned or operated by a game vendor (e.g. arcade or casino). Generally, it is common in the gaming art to offer games "online" over networks via personal computers and set-top cable boxes. With respect to lotteries, Sarno teaches that lottery system that allows a users to participate on a personal computer. *See col. 1:7-2:5.* In view of Sarno, it would be obvious to an artisan to modify the lottery gaming device disclosed by Dickinson to add the feature of using user equipment. As suggested by Sarno allowing players to participate in lotteries from their homes using user equipment offers several benefits including (i) increasing lottery revenues by allowing participation by remotely located players, (ii) providing lotteries access to players who cannot afford to travel to jurisdictions that allow lotteries, (iii) enhancing convenience and ease of access, and (iv) offering the potential for enormous winnings. *See id.*

Regarding the limiting the listing of lotteries, it a common commercial practice to limit the information provided to consumers based on their particular location. For example, television commercials for local businesses in California are not broadcast to consumers in Maryland because the

information holds little relevance to a Marylander. In other words, the information is filtered based on the location of a user. In computer-based systems, it is also known to perform location-based filtering of information. For example, Tso deals with the problem of limiting the amount of information displayed to users on computer terminals connected to networks. It notes that computers can provide too much information such that users are required to sift through the information presented in order to determine what information is relevant. *See col. 1:7-10, 1:44-2:44.* To solve this problem, Tso discloses a system that automatically filters data distributed to users over a network based on a set of selected criteria, including the location of a user. *See id.* Notably, in a system where a user's terminal is mobile, Tso filters data based on real-time location information for each user. *See id.* In view of Tso, it would have been obvious to an artisan at the time of the invention to modify the lottery system disclosed by Dickinson, wherein computer terminals connected to a network list a plurality of lottery games, to add the feature of limiting the list of lotteries based on a user's particular location. As suggested by Tso, the modification would enhance the system for users by freeing them from the burden of determining which information is relevant to them. *See col. 1:23-27, 1:47-52.* Furthermore, the modification would enhance the system for providers by allowing them to focus their services on users who are interested in their service. *See col. 1:34-37, 1:55-65.* Still furthermore, the modification would enhance the system by reducing waste of network bandwidth and network transmission capability by transmitting data to terminals which cannot make use of the data. *See id.*

Consequently, when the prior art is taken as a whole at a time prior to the invention by one of ordinary skill in the art, Dickinson, Sarno and Tso collectively suggest a interactive wagering system employing user equipment wherein a list of lotteries in which a user can participate is based on the particular location of the user.

Claims 2-5, 7, 9, 12-15, 17, 19, 66-69, 71, 73, 76-79, 81 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson in view of Sarno, US 6,024,641 and Tso et al., as applied to claims 1, 11, 33 and 49 above, in further view of LottoBot, (Feb. 1999), downloaded from the Internet website http://web.archive.org/web/19991128172018/-http://lottobot.net/ on Feb. 25, 2004.

Claims 2, 12, 66 and 76: As discussed above, the lottery system suggested by Dickinson in view of Sarno and Tso describes all the features of the claim except notifying the user that the results to a lottery are available. *LottoBot* discloses an analogous lottery system allowing users to access lottery data over the Internet through the user's computer. In particular, the system notifies users that lottery results in which the user participated are available. *See p. 1.* In view of *LottoBot*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify, wherein remotely located users participate in lotteries through over a network, to add the feature of notifying the users that their lottery results are available. As taught in *LottoBot*, the modification would enhance the lottery system by allowing users who participate in one or more lotteries to be automatically informed of the results and thereby provide a more convenient system by reducing the attention required of the user. *See p. 20.*

Claims 3, 13, 67 and 77, : *LottoBot* additionally teaches transmitting notification as a computer email or pager message. *See p. 1.* Telephone messages, pop-up overlay messages and icons are equivalent methods known in the art for the same purpose as emails and pager messaging for indicating a message data on electronic devices.

Claims 4, 14, 68 and 78: *LottoBot* additionally teaches displaying the results to at least one of the lotteries in which the user participated. *See p. 1.*

Claims 5, 15, 69 and 79: *LottoBot* additionally teaches indicating whether the user won for each of the lotteries for which the user participated. *See p. 1, 20.*

Claims 7, 17, 71 and 81: *LottoBot* additionally teaches reminding the user of an upcoming lottery drawing associated with at least on of the lotteries in which the user participated. *See pp. 1 (e.g. jackpot alerts).*

Claims 9, 19, 73 and 83 *LottoBot* teaches displaying a user interface to the user for use in creating a lottery wager , wherein the user interface is customized for each one of the lotteries. In particular, the reference displays a separate display for each lottery and type. *See p. 4.*

Claims 6, 16, 70 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson in view of Sarno, US 6,024,641 and Tso et al., as applied above, in further view of Luciano et al., U.S Patent 6,168,521 (Jan. 2, 2001).

The lottery system suggested by Dickinson in view of Sarno and Tso teaches all the features of the instant claims except a multimedia recording of the lottery drawings associated with the lotteries in which the user participated. Luciano discloses an analogous electronic lottery game system utilizing multiple player-activated video terminals that are linked to computers. *See abstract.* Each player places a wager and selects his lottery draw choices and the system enrolls the player in a future lottery game after the player makes his choices. *See id.* After automatically drawing lottery numbers, the system displays the result of the selected game displayed at the player's terminal in such a manner as to provide the excitement of a real time game. *See abstract; fig. 9; 1:21-58; 8:21-58.* The player can at anytime activate a stored replay of the drawing game. *See fig. 6(627); col. 8:12-20.* In view of Luciano, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the lottery

system suggested by Dickinson in view of Sarno and Tso to add the feature of recording of the lottery drawings associated with the lotteries in which the user participated. As suggested by Luciano, recording the results of a lottery drawing enhances the entertainment provided to players by offering the excitement of a real time game and allowing players to replay the game at any time. *See abstract; fig. 9; 1:21-58, 8:10-58.*

Claims 8, 18, 72 and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson in view of Sarno, US 6,024,641 and Tso et al., as applied above, in further view of *SGI Insights,* Scientific Gaming International, vol. 1, issue no. 5 (Jan. 1999).

The lottery system suggested by Dickinson in view of Sarno and Tso describes all the features of the claims except giving the user the ability to generate lottery gift certificates. SGI Insights teaches that it is known to give users the ability to order lottery gift certificates. *See p. 4.* In view of SGI Insight, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the lottery system suggested by Dickinson in view of Sarno and Tso, wherein users generate lottery entries over a telecommunication link, to add the feature of giving the user the ability to generate lottery gift certificates. As suggested in SGI Insight, lottery gift certificates are very popular amongst users. *See id.* Thus offering them to users would enhance the operator's revenues by increase purchases through the system.

Claims 10, 20, 74 and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickinson in view of Sarno, US 6,024,641 and Tso et al., as applied above, in further view of McCollom et al., U.S. Patent Application Publication 2002/001623 A1 (Jan. 24, 2002).

The lottery system suggested by Dickinson in view of Sarno and Tso describes all the features of the claims except giving the user the ability to finalize a wager at a later time and reminding the user to

finalize the wager. Regardless, such features are a common commercial practice in "online" businesses offering products and services over Internet web pages. For example, McCollom teaches an analogous system allowing users the purchase items and coupons over the Internet wherein users are given the ability to finalize a purchase at a later time and reminded the user to finalize the purchase. In particular, the reference allows to place purchases in a "shopping basket" or "wish list" for later purchase. *See fig. 13, 14, 17.* The system's display provides an indication reminding the user that the purchase is not finalized. *See fig. 21, 22; p. 8, ¶ 0107*. In view of McCollom, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the lottery system suggested by Dickinson in view of Sarno and Tso, wherein users purchase lottery tickets over the Internet, to add the features of giving the user the ability to finalize a wager at a later time and reminding the user to finalize the wager. As taught by McCollom, the modification would improve the system by allowing users to browse, assemble and store selections until the time the elect to make a purchase. *See p.10, ¶¶ 0132-0137.*

Claims 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al., U.S. 6,325,716 B1 (Dec. 4, 2001) in view of Archer, U.S. 6,277,026 B1 (Aug. 21, 2001)

Claims 21 and 27: Walker discloses the claimed features of giving the user the ability to set conditions via user equipment on which an interactive wagering application is partially implemented and automatically participating in the lottery on the behalf of the user when the conditions have been met. *See col. 2:36-3:35.* However, Walker does not describe the electronic user equipment. Instead, Walker employs paper tickets.

Archer teaches an analogous system for selling lottery tickets online via user equipment. *See fig. 1, 4A; col. 5:10-15.* In view of Archer, it would have been obvious to an artisan at the time of the invention to modify Walker, wherein users submit lottery entries using paper tickets, to instead use

electronic user equipment. As suggested by Archer, the modification facilitate the sale and distribution of lottery tickets by enabling online sale and distribution and thereby enhance revenues. *See col. 1:36-67.*

Claims 22 and 28: Walker discloses automatically participating in the lottery comprises using a default set of lottery numbers. *See col. 3:1-8, 5:1-19.*

Claims 23 and 29: Walker discloses default sets of lottery numbers are user-specified. *See id.*

Claims 24 and 30: Walker discloses automatically participating in the lottery comprises using a set of randomly generated lottery numbers. *See id.*

Claims 25 and 31: Walker discloses conditions based on factors selected from the group consisting of a period of time from the last time the user participated, the lottery prize, the odds of winning and any combination thereof. *See col. 2:54-3:1; 4:11-27.* In regards, to the odds of winning, the reference teaches enrolling a ticket based on a minimum payout, which determines the ticket's expected payout (i.e. odds of winning a particular payout).

Claims 26 and 32: Walker discloses automatically participating in the lottery on behalf of the user every time the lottery is offered. *See col. 1:55-64, 2:54-64.*

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new grounds of rejection necessitated by that applicant's amendment. Responses to selected arguments are provided below.

The applicant argues that there is no motivation to combine the Dickinson and Sarno. The examiner respectfully disagrees. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the standard of patentability is what the prior art, taken as a whole, suggests to an artisan at the time of the invention. *In re Merck & Co., Inc.*, 800 F.2d 1091,1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The question is not only what the references expressly teach, but what they would collectively suggest to one of ordinary skill in the art. *In re Simon*, 461 F.2d 1387, 1390, 174 USPQ 114, 116 (CCPA 1972). In this case, the applicant apparently overlooked the four express motivations to combine provided in Sarno and listed in the office action on page 2. In particular, Sarno states that allowing players to participate in lotteries from their homes using user equipment offers several benefits including (i) increasing lottery revenues by allowing participation by remotely located players, (ii) providing lotteries access to players who cannot afford to travel to jurisdictions that allow lotteries, (iii) enhancing convenience and ease of access, and (iv) offering the potential for enormous winnings. *See col. 1:7-2:5*. Thus, when the prior art is taken as a whole by one of ordinary skill in the art, it collectively suggests modifying the lottery system disclosed by Dickinson to employ" user equipment" as a lottery terminal.

Furthermore, the applicant argues that the examiner's conclusion of obviousness is based upon improper hindsight reasoning. In response, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As discussed above, Sarno provides at least four reasons for an artisan to modify the lottery system disclosed by Dickinson to employ" user equipment" as a lottery terminal. Thus, the conclusion of obviousness is based entirely the

level of ordinary skill at the time the claimed invention was made, and not on knowledge gleaned from the applicant's disclosure.

Applicant's arguments with respect to claims 21-32 have been fully considered but they are not persuasive.

The applicant argues that there is no motivation to combine the references. The examiner respectfully disagrees. Again, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the standard of patentability is what the prior art, taken as a whole, suggests to an artisan at the time of the invention. *In re Merck & Co., Inc.*, 800 F.2d 1091,1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The question is not only what the references expressly teach, but what they would collectively suggest to one of ordinary skill in the art. *In re Simon*, 461 F.2d 1387, 1390, 174 USPQ 114, 116 (CCPA 1972).

In this case, Walker discloses a lottery system allowing users to set conditions via user equipment on which an interactive wagering application is partially implemented and automatically participating in the lottery on the behalf of the user when the conditions have been met. *See col. 2:36-3:35.* However, Walker does not describe the electronic user equipment. Archer discloses an analogous system for selling lottery tickets online via user equipment. *See fig. 1, 4A; col. 5:10-15.* It states that distributing lottery tickets online facilitates the sale and distribution of tickets, thereby enhance revenues for an operator. *See col. 1:36-67.* Thus, when the prior art is taken as a whole at at time prior to the applicants invention, it collectively suggests modifying the lottery system disclosed by Walker, wherein a player's ticket it automatically enrolled in a lottery when certain conditions are met, to selling lottery tickets online via user equipment.

Furthermore, the applicant argues that the examiner's conclusion of obviousness is based upon improper hindsight reasoning. Again, the examiner recognizes that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, as discussed above, Archer suggets modifying Walker to selling lottery tickets online via user equipment. *See col. 1.36-67.* Thus, the conclusion of obviousness is based entirely the level of ordinary skill at the time the claimed invention was made, and not on knowledge gleaned from the applicant's disclosure.

Thus, for the reasons above, the rejection of claims 21-32 is maintained.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

s.a.

MARK SAGER
PRIMARY EXAMINER